Applicant : Thomas G. Woolston   Attorney's Docket No.: 13466-002005
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Remarks

I.   The Restriction Requirement of Apparatus and Process is Improper.

Claims 11-24 remain pending in the application and are allegedly subject to restriction requirement under 35 U.S.C. 121. The Office Action suggests that the claims are drawn to two groups.

I.   Claims 11-20 are allegedly drawn to a method of bidding, classified in class 705.

II.   Claims 21-24 are allegedly drawn to a computer network, classified in class 709, subclass 202.

Applicant elects Group II with traverse. The Office Action alleges that "the apparatus [(Group II., claims 21-24)] can be used to practice a materially different process such as a scheduler device wherein the handler program is used to post a reminder message to one or more users at a designate time." (Office Action, page 2). Applicant respectfully traverses.

According to MPEP 806.05(e), "[p]rocess and apparatus for its practice can be distinct inventions, if either or both of the following can be shown: (A) that the process *as claimed* can be practiced by another *materially different apparatus or by hand*; or (B) that the apparatus *as claimed* can be used to practice another *materially different process*." As to part (A), claims 11-20 clearly recite *a computer network-based* method for facilitating commerce. By expressly reciting elements such as a computer application program; a remote topically arranged internet-based auction system; and a communication handler program executing on a host computer, Applicant submits that *as claimed*, the method for facilitating commerce cannot be practiced by another materially different apparatus or by hand other than the claimed computer network system.

As to part (B), which the Office Action relies upon to allegedly support the restriction requirement, Applicant respectfully submits that the restriction requirement is improper for the following reasons. First, part (B) requires that "apparatus *as claimed* can be used to practice another *materially different process*. Therefore, the burden is on the Office to identify a materially different *process* other than the claimed computer network-based method of facilitating commerce at a remote topically arranged internet-based auction system. Instead of

providing a materially different *process*, the Office Action suggests that the system of claims 21-24 can be used to practice "a scheduler *device*." Applicant submits that a scheduler *device* is not a process but an apparatus. Therefore, the computer network based-system as recited in claims 21-24 cannot be used to practice a scheduler *device* or any other apparatus.

Second, Applicant submits that the computer network based-system *as claimed* cannot be used to practice a materially different process other than the method of facilitating commerce at an internet-based auction as recited in claims 21-24. Claim 21 is illustrative and listed below for convenience.

> A *computer network based-system operative to facilitate commerce at an internet-based auction*, the computer network based-system comprising:
>
> *a computer system executing a computer application program operative to authorizing a plurality of remote seller participants to post*, using a computer application program executing on a computer system associated with the plurality of remote seller participants, *a plurality of items for auction at the remote topically arranged internet-based auction system, wherein the remote seller participants are authorized to operate a computer application program to coordinate asynchronous generation and scheduling of automated ascending bid auction instances in the remote topically arranged internet-based auction system* while the computer application program is isolated from communication with the remote topically arranged internet-based auction system;
>
> the *computer application program retrieving information about a topographical structure of the remote internet based-auction system from a data repository* while the computer application program is isolated from communication with the remote topically arranged internet based auction system;
>
> a *database* stored in the computer system having a structure corresponding to the topographical structure of the remote internet based-auction system *including a selection of topographical categories and sub-categories for the topical arrangement of multiple auction instances by the plurality of seller participants*;
>
> the *computer application program further including a user interface program* operative to provide to the plurality of seller participants the selection of topographical categories and sub-categories for *inputting data to build a data record of the plurality of items that will be subsequently posted into the remote topically arranged internet-based auction system*, the selection of the topographical categories and sub-categories based at least in part from the information about the topographical structure of the remote topically arranged internet-based auction system retrieved from the data repository to assure proper linkage into the topographical structure maintained by the remote topically arranged internet-based auction system when the computer application program subsequently communicates the data record of the items *to create the automated*

ascending bid auction instances for the plurality of items at the remote topically arranged internet-based auction system;

the *user interface program* operative to provide one or more data input fields *to receive from the plurality of remote participant sellers a title and a subjective textual description for the plurality of items;*

the *computer system generating a data header* that contains a user identification code *corresponding to the plurality of remote participant sellers and an authorization password* for the data record created for the plurality of items;

a *communication handler program* executing on a host computer system housing the remote topically arranged internet-based auction system *receiving information* from the computer application program executing on the computer system *about the plurality of items to be auctioned,* the received information comprising the selection of topographical categories and sub-categories, the title and the subjective textual description of the plurality of items, and the data header;

the *handler program* further processing the received information at the host computer system housing the remote internet based-auction system into a presentation format comprising scheduling information received from the seller participant operating the computer application program to (a) post the data record in the remote topically arranged internet-based auction system *to initiate the automated ascending bid auction instances at the remote topically arranged internet-based computer system,* (b) *designate a time* at which the computer application program will contact the remote topically arranged internet-based auction system to post at least one data record *to initiate the automated ascending bid auction instance for the at least one data record* at the remote topically arranged internet-based auction system, or (c) post the data record in the remote topically arranged internet-based auction system designating the plurality of items as on-hold awaiting the automated ascending bid auction instance start date at the remote topically arranged internet-based auction system;

the *host computer system* further presenting the presentation formatted information to a plurality of bidding internet participants, and *receiving at least one bid for the plurality of items* from at least one of the plurality of bidding internet participants.

It is important to note that claim 21 recites a system and not an apparatus. There is a distinction between the two. While an apparatus can be a single individual machinery or device, the system *as claimed* necessarily cannot be a single individual machinery or device. Specifically, claim 21 recites *a computer network based-system operative to facilitate commerce at an internet-based auction*. Therefore, a computer *system* made up of multiple individual components are recited, wherein each component is configured according to a specific

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function to be performed, and each function is directed to *facilitating commerce at an internet-based auction*.

First, the computer network-based system is directed to executing a computer application program to allow a seller to post items for *auction at an internet-based auction system* and operate a computer program to generate and schedule *automated ascending bid auction instances in the remote topically arranged internet-based auction*. While the computer network-based system performs a scheduling function, the schedule is specifically directed to automating ascending bid auction instances in the internet-based auction. In contrast to what is asserted by the Office Action, any scheduling function practiced by the computer network-based system *as claimed* must be materially relevant and related to the claimed method of facilitating commerce in an internet-based auction system.

The computer network-based system includes additional components configured to perform processes directed to facilitating commerce at an internet-based auction system. The computer network-based system further includes at least a database, a user interface, and a communication handler program strictly configured to facilitate commerce at an internet-based auction system. While the communication handler program processes information including scheduling information, the scheduling information is processed to (a) post the data record in the remote topically arranged internet-based auction system *to initiate the automated ascending bid auction instances at the remote topically arranged internet-based computer system*, (b) designate a time at which the computer application program will contact the remote topically arranged internet-based auction system to post at least one data record *to initiate the automated ascending bid auction instance for the at least one data record at the remote topically arranged internet-based auction system*, or (c) post the data record in the remote topically arranged internet-based auction system *designating the plurality of items as on-hold awaiting the automated ascending bid auction instance start date at the remote topically arranged internet-based auction system*. Thus, the scheduling information is specifically material and directed to the claimed internet-based auction system, and the communication handler program *as claimed* cannot be used to practice a materially different scheduling process as alleged by the Office Action. Clearly, the handler program *as claimed* is configured to processing scheduling information directed to *automating ascending bid auction instances*.

In addition, the scheduling function performed by the communication handler program is only a portion of the entire process performed by the computer network-based system *as claimed* in claim 21. Applicant submits that the claim must be considered as whole with the meaning of each and every word included. Thus, it is improper to simply focus on a portion of the claim and to scrutinize it outside of the entire claimed subject matter. By suggesting, as the Office Action states, that the handler program can be used to "post a reminder message to one or more users at a designate time," the Office Action improperly assumes that this portion of the computer network-based system represents the entire computer network-based system *as claimed* in claim 21. Applicant submits that *as claimed* in claim 21, the *communication handler program* must be executed on a *host computer system housing the remote topically arranged internet-based auction system receiving information from the computer application program executing on the computer system about the plurality of items to be auctioned*. Clearly, the scheduling function of the handler program must be drawn to facilitating commerce at an internet-based auction system.

Further, in applying the two prong test of restriction requirement outlined in MPEP § 806.05(e), the burden in on the Office to prove that the apparatus *as claimed* can be used to practice another materially different process. This means that it must be proven that the entire apparatus can be used to practice another materially different process. With respect to claim 21, it must be proven that the entire computer network-based system can be used to practice another materially different process. However, as described above, all of the components that make up the computer network-based system are directed to facilitating commerce in an internet-based auction system. For example, the user interface allows sellers to input product information to facilitate posting of the product to be auctioned. This user interface, which is a component of the computer network-based system, cannot be used to practice a scheduling device materially different from the scheduling information for automating ascending bid instances at an internet-based auction system *as claimed* in claim 21.

For at least these reasons, Applicant submits that the restriction requirement is improper and respectfully requests consideration to withdraw the restriction requirement.

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II.   Restriction Requirement of Multiple Species is improper.

Group II is allegedly subject to a further restriction requirement among plural species as follows:

Species defined by claim(s) 22 drawn to an ascending bid device with an manual start feature;

Species defined by claim(s) 23 drawn to a user ID identifier device;

Species defined by claim(s) 24 drawn to a data message device.

Claim 21 is identified as a generic claim.

Applicant elects species defined by claim 22 with traverse. Applicant submits that there is a clear relationship between species, and thus are not independent inventions.

> *Where there is no disclosure of a relationship between species (see MPEP §*
> *806.04(b)), they are independent inventions.* A requirement for restriction is
> permissible if there is a patentable difference between the species as claimed and
> there would be a serious burden on the examiner if restriction is not required. See
> MPEP § 803 and § 808.02.

> *Where there is a relationship disclosed between species, such disclosed relation*
> *must be discussed and reasons advanced leading to the conclusion that the*
> *disclosed relation does not prevent restriction,* in order to establish the propriety
> of restriction. MPEP 808.01(a)

The Office Action improperly alleges that claims 22, 23, and 24 are drawn to different *devices*. Claims 22, 23, and 24 depend from generic claim 21, and thus include exactly the same components of the computer network-based system *as claimed* in claim 21. No additional components have been added to any of the three dependent claims. Therefore claims 22, 23, 24 are related to each other by having the same exact components of the computer network-based system *as claimed* in claim 21. In addition, Applicant submits that claim 21 recites *a computer network based-system to facilitate commerce at an internet-based auction, the computer network based-system comprising.* The use of the open language, *"comprising,"* necessarily means that addition material processes directed to facilitating commerce at an internet-based auction than

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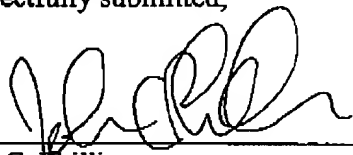Page : 8 of 8

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what is expressly recited can be performed by the computer internet-based system. Thus, in dependent claims 22, 23, and 24, these additional material processes are simply being recited to expressly state the functional requirements.

For at least these reasons, Applicant submits that the restriction requirement of plural species is improper and respectfully requests reconsideration and withdrawal of the restriction requirement.

Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: 11/18/05

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